

ESTTA Tracking number: **ESTTA291218**

Filing date: **06/22/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	K-Swiss Inc.
Granted to Date of previous extension	06/21/2009
Address	31248 Oak Crest Drive Westlake Village, CA 91361 UNITED STATES
Attorney information	Neil D. Greenstein TechMark 1917 Palomar Oaks Way, Suite 300 Carlsbad, CA 92008 UNITED STATES ndg@techmark.com, cmp@techmark.com, dla@techmark.com Phone: 8587040510, X303

### Applicant Information

Application No	77366912	Publication date	12/23/2008
Opposition Filing Date	06/22/2009	Opposition Period Ends	06/21/2009
Applicant	CFRI-NCA Palladium Venture, L.L.C. 15 Old Danbury Road Wilton, CT 058970812 UNITED STATES		

### Goods/Services Affected by Opposition

Class 025. First Use: 1990/08/17 First Use In Commerce: 1990/08/17  
All goods and services in the class are opposed, namely: Sweat shirts; T-shirts; Shirts; Jackets; Hats; Caps

### Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1827532	Application Date	10/11/1991
Registration Date	03/22/1994	Foreign Priority Date	04/29/1991
Word Mark	PALLADIUM		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 025. First use: clothing for men, women and children; namely, shirts, pants, ties, scarves, suits, sweatshirts, jackets, teeshirts, pullovers, coats, raincoats, parkas, dresses and blouses

U.S. Registration No.	1160084	Application Date	09/26/1977
Registration Date	07/07/1981	Foreign Priority Date	NONE
Word Mark	PALLADIUM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1956/06/00 First Use In Commerce: 1970/00/00 Footwear		

U.S. Registration No.	2394617	Application Date	04/07/1998
Registration Date	10/17/2000	Foreign Priority Date	NONE
Word Mark	PALLADIUM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1998/02/20 First Use In Commerce: 1998/02/20 HATS		

U.S. Registration No.	2394618	Application Date	04/07/1998
Registration Date	10/17/2000	Foreign Priority Date	NONE
Word Mark	THE ORIGINAL PALLADIUM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1956/06/00 First Use In Commerce: 1970/00/00 CLOTHING FOR MEN, WOMEN AND CHILDREN; NAMELY, SHIRTS, PANTS,		

	TIES, SCARVES, SUITS, SWEATSHIRTS, JACKETS, TEESHIRTS, PULLOVERS, COATS, RAINCOATS, DRESSES, BLOUSES, FOOTWEAR AND HATS
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/ndg-pto/
Name	Neil D. Greenstein
Date	06/22/2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

K-Swiss Inc.,

Opposer,

v.

CFRI-NCA Palladium Venture LLC,

Applicant.

Opposition No.

**NOTICE OF OPPOSITION**

In the matter of the application for registration of:

Applicant's Mark: HOLLYWOOD PALLADIUM

Serial No.: 77/366,912

International Classes: 25

Extended Deadline for filing

Notice of Opposition: June 22, 2009

United States Patent and Trademark Office

Trademark Trial and Appeal Board

P.O. Box 1451

Alexandria, VA 22313-1451

K-SWISS INC., a corporation organized and existing under the laws of the State of Delaware, with its principal place of business at 21348 Oak Crest Drive, Westlake Village, CA 91361, believes it will be damaged by registration on the Principal Register of the mark shown in Application Serial No. 77/366,912 and hereby opposes registration of the above-identified application on the following grounds:

1. K-Swiss is now and, its predecessor, (collectively, sometimes "Opposer") for many years has been engaged in the manufacture, promotion, advertising and sale of a variety of

goods (“Opposer’s Goods”), including, without limitation, clothing and footwear, and related sports products. Opposer uses its PALLADIUM mark (“Opposer’s Mark”) on and in association with its goods.

2. K-Swiss is the owner of the following U.S. Trademark Registrations:

A. 1,827,532, registered on March 22, 1994, for the PALLADIUM mark for clothing for men, women and children;

B. 1,160,084, registered on July 7, 1981, for the PALLADIUM mark, for footwear;

C. 2,394,617, registered on October 17, 2000, for the PALLADIUM mark, for hats;

D. 2,394,618, registered on October 17, 2000, for the PALLADIUM mark for clothing for men, women and children.

3. All of K-Swiss’ registrations identified above (the “K-Swiss PALLADIUM Registrations”) are extant, have been registered for more than 5 years and all have had declarations filed under Sections 8 and 15 of the Trademark Act. As such, the K-Swiss PALLADIUM Registrations are incontestible and are conclusive proof of the validity of the PALLADIUM mark, of K-Swiss’ ownership of the PALLADIUM mark, and of K-Swiss’ exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in such registrations.

4. Opposer is a competitor of Applicant and/or distributes goods that are of the same type, are related to and/or compete with the goods listed in Applicant’s application.

5. Applicant acquired no rights, inchoate or otherwise in Applicant's Mark for the goods specified in Application Serial Number 77/366,912 prior to January 8, 2008.

6. Applicant's HOLLYWOOD PALLADIUM mark is confusingly similar to Opposer's PALLADIUM mark.

7. Opposer has used its PALLADIUM mark for over a half-century and long prior to Applicant's priority date. As such, Opposer's common law rights in the PALLADIUM mark are superior to Applicant's rights.

8. Applicant is not now and never was entitled to registration on the Principal Register of the alleged trademark depicted in Application Serial No. 77/366,912 for the goods specified therein ("Applicant's Goods").

9. Opposer uses its PALLADIUM mark on catalogs, publications, labels and/or tags affixed to goods and/or packaging for goods, and/or in other ways customary in the trade.

10. Opposer has continuously and extensively promoted the above-mentioned PALLADIUM trademark in connection with Opposer's Goods. As a result, the PALLADIUM mark has become well known to and favorably received by the general consuming public as being associated with Opposer's Goods.

11. Purchasers recognize K-Swiss as a supplier of Opposer's Goods in connection with the PALLADIUM mark. Such purchasers would likely assume that Applicant's Goods sold under Applicant's Mark originated with K-Swiss.

12. Opposer has built a valuable goodwill in the PALLADIUM mark used in connection with Opposer's Goods. If Applicant is permitted to register and use Applicant's Mark in connection with Applicant's Goods, confusion in the trade would result. Purchasers

familiar with Opposer's Goods would believe that Applicant's Goods sold under Applicant's Mark are, contrary to fact, associated with, endorsed by or in some way related to Opposer, or actually are the goods of Opposer. Any fault or defect in connection with Applicant's Goods would reflect upon and seriously injure the reputation which has been established for Opposer's Goods. Moreover, purchasers familiar with the Opposer's PALLADIUM mark would confuse such mark with Applicant's Mark and might purchase or use Applicant's Goods in the belief that they are purchasing or using Opposer's Goods. This confusion would result in a loss of sales to K-Swiss and damage both its income and its reputation.

13. Applicant's Goods are related to Opposer's Goods and Applicant's Mark is identical to Opposer's PALLADIUM mark. Applicant's Mark when used in association with Applicant's Goods is likely to cause confusion, mistake or deception with Opposer's Goods. Thus, the registration of Applicant's Mark is precluded under Section 2(d) of the Trademark Act. Moreover, registration of Applicant's Mark would create rights inconsistent with K-Swiss' right to use its marks.

14. If Applicant is granted the registration herein opposed, Applicant would have *prima facie* exclusive rights to Applicant's Mark and all confusingly similar marks, thus placing Applicant in a position to harass, annoy, damage and injure K-Swiss and K-Swiss' customers.

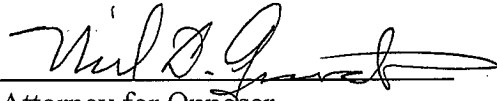
WHEREFORE, Opposer requests that registration of Applicant's alleged trademark, as show in Application Serial No. 77/366,912 be denied and that this Opposition be sustained.

Please recognize Neil D. Greenstein, ([ndg@techmark.com](mailto:ndg@techmark.com)) and Martin R. Greenstein with an address of TechMark, 1917 Palomar Oaks Way, Suite 300, Carlsbad, CA 92008, (858) 704-0515, members in good standing of the Bar of the State of California, as Opposer's attorneys

in connection with this opposition proceeding. All correspondence from the Trademark Trial and Appeal Board should be directed to Neil D. Greenstein.

Dated: June 22, 2009

NEIL D. GREENSTEIN  
TECHMARK

By:   
Attorney for Opposer

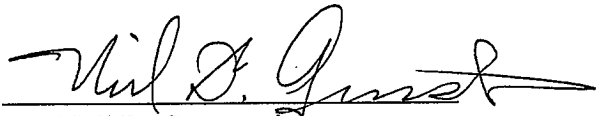
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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **NOTICE OF OPPOSITION** has been served on Applicant's Attorney of Record, by mailing said copy on June 22, 2009 by First Class Mail, postage prepaid to the following:

Randall K. Broberg  
Michael Adele  
ALLEN MATKINS  
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San Diego CA 92130  
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Dated: June 22, 2009

  
Neil D. Greenstein